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Paper No. 239

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

STEPHEN A. A. GODDARD

Junior Party
(Application 07/982,949),

v.

THOMAS L. GAMBARO

Senior Party
(Patent No. 5,332,322)

Patent Interference No. 104,073

FINAL DECISION PURSUANT TO 37 CFR § 1.658(a)

Before McKELVEY, Senior Administrative Patent Judge, and LEE and TIERNEY, Administrative Patent Judges.

TIERNEY, Administrative Patent Judge.

Junior Party Goddard has failed to prove an actual reduction to practice date prior to Senior Party Gambaro's filing date of January 11, 1993. Accordingly, Gambaro prevails in this interference and judgment will be entered against Goddard.

I. Introduction

The interference is before a merits panel for entry of a final decision. Oral argument took place on February 1, 2001. Present at oral argument for Junior Party Goddard was James H. Laughlin, Jr., Esq., and inventor Stephen A. A. Goddard. Senior Party Gambaro appeared pro se. The interference involves two independent inventors and in this sense is reminiscent of numerous interferences which took place in the late 1800's and early 1900's.

II. Findings of fact

The record supports the following findings of fact by a preponderance of the evidence.

A. The Interference

1. The interference involves Goddard's U.S. Application 07/982,949 (Goddard '949) and Gambaro's U.S. Patent 5,332,322 (Gambaro '322). (Paper No. 1 and 2, Notice Declaring Interference). Gambaro is the senior party and Goddard is the junior party.

B. Junior Party

2. Stephen A. A. Goddard is the real party in interest in Goddard '949, which was filed on February 22, 1993.[1] (Paper No. 8, Real Party in Interest; Paper No. 1, Notice Declaring Interference).

[1] Goddard's preliminary motion to be accorded benefit under 37 CFR §1.633(f) was denied on January 12, 1999. (Paper No. 44, Memorandum Opinion and Order).

C. Senior Party

3. Motionless Keyboard Company is the real party in interest in Gambaro '322, which was filed on January 11, 1993. (Paper No. 10, Notice Pursuant to 37 CFR §1.602; Paper No. 1, Notice Declaring Interference). Gambaro '322 is said to be a continuation-in-part of Gambaro U.S. Application No. 07/711,760 (Gambaro '760) filed June 6, 1991 now U.S. Patent No. 5,178,477. (Gambaro '322, front page). Gambaro '322 has not been accorded the benefit of the Gambaro '760 filing date. (Paper No. 65, Decision on Preliminary Motions).

D. The Count

4. This interference was declared on January 20, 1998. (Paper No. 1 and 2, Notice Declaring Interference). Count 1 is the sole count in the interference. (Paper No. 1 and 2, Notice Declaring Interference; Paper No. 65, Decision on Preliminary Motions). Count 1, which is identical to Gambaro's claim 1 and Goddard's claim 26, reads as follows (material in brackets [ ] added):

Count 1

> **[1]** A hand-held device **[2]** for entering information into an electronic system via a keyboard, the device comprising:
>
> > **[3]** a housing having a grippable portion which permits the device to be held in one hand with the thumb free to move at least temporarily to a predetermined key-actuation position while the device is held,
> >
> > **[4]** a concavity in said housing at said key-actuation position, and
> >
> > **[5]** a thumb-associable cluster of keys forming a keyboard within said concavity, each of the plurality of keys in said cluster being selectively actuable via mixed lateral, and slight endo, translation of a thumb within said concavity, **[6]** whereby information is entered into an electronic system.

5. The claims of the parties are as follows:

a) Goddard '949: Claims 26-28, and 30-38

b) Gambaro '322: Claims 1-5

6. The claims of the parties which correspond to Count 1 are as follows:

a) Goddard '949: Claims 26-28, 30 and 31

b) Gambaro '322: Claims 1-5

7. The claims of the parties which do not correspond to Count 1, and therefore are not involved in the interference, are as follows:

a) Goddard '949: Claims 32-38

b) Gambaro '322: None

OPINION

III. The Count

Count 1 defines a hand-held device for entering information into an electronic system. As shown above, Count 1 contains at least six different requirements **[1]** through **[6]**. Specifically, Count 1 is directed to **[1]** "a hand-held device" for **[2]** "entering information into an electronic system via a keyboard". Count 1 specifies that the device has **[3]** a housing with a grippable portion that allows the device to be held in one hand where the thumb is free to move to key-actuation positions. At the key actuation position there is **[4]** a concavity having **[5]** a

cluster of thumb-associable keys, whereby **[6]** "the information is entered into an electronic system." Accordingly, per requirements **[2]** and **[6]**, the hand-held device must be capable of entering information to an electronic system.

Goddard, as best we can understand its argument, contends that there are only four requirements (**[1]**, **[3]**, **[4]**, **[5]**) in Count 1. Goddard, however, has not provided a convincing explanation of why we are to ignore the plain language of the count with respect to requirements **[2]** and **[6]**. Specifically, Goddard states that:

> The party Gambaro does not seem to argue against the fact that the invention of the count requires ergonomic structure but seems to want this Board to impose a structural requirement on the count which does not exist. The "whereby" clause **[6]** helps define the purpose of the invention but it is not structure. No one can prove a "whereby" clause because it does not exist in tangible form.

(Goddard's Brief, Paper No. 223, p. 3, bracket **[6]** added). Accordingly, Goddard appears to argue that the capability of entering information into an electronic system cannot be proven. Yet we are not persuaded that functional features exist only in the abstract and thus are incapable of being proven. A completed device can be activated, operated, and then observed to determine if the claimed functional features are performed. For example, a switch must switch; a transmitter must transmit; a light bulb must light; a heater must heat. Thus, Goddard has failed to convince us that his alleged predicament is real – that functional features cannot be proven. Where the party charged with the burden of proof is incapable of proving a claim requirement, we do not eliminate the claim requirement, but rather, hold that the party has failed to meet its burden of proof.

Goddard's attempt to ignore the plain language of the count overlooks established precedent. When the "whereby" clause recites a positive limitation to the claim, it will be given effect whereas when it merely states the result of the limitations in the claim the clause is construed as adding nothing to the patentability or substance of the claim. *Compare Simpson et al. v. Neracher et al.*, 191 F.2d 416, 432, 91 USPQ 43, 57 (CCPA 1951) *and Israel v. Cresswell*, 166 F.2d 153, 156, 76 USPQ 594, 597 (CCPA 1948). The whereby clause **[2]** requires that "information is entered into an electronic system." Moreover, in addition to the whereby clause, this feature is already required by other limitations of the count. Thus, this feature must be accounted for when demonstrating the reduction of each element of the count.

Requirement **[2]**, entering information into an electronic system, is consistent with the limitation recited by the whereby clause **[6]**. The drafter of Gambaro claim 1 stated the function of transferring information to an electronic system, not once, but twice. Thus, the count provides a unified and internally consistent recitation of the invention as it begins and ends with

statements extolling the hand-held devices ability to enter data into an electronic system. *See Pitney Bowes Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-1166 (Fed. Cir. 1999). Accordingly, requirement **[2]** gives life, meaning and vitality to the claim. *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 480-81 (CCPA 1951).

As such, the clear and unambiguous language of the count, taken as a whole, requires the inventive device be capable of entering information into an electronic system.

IV. Decision on Priority

Priority in an interference is awarded to the party establishing either (1) the earlier date of reduction to practice, or (2) the earlier date of conception, but a later date of reduction to practice, coupled with a reasonable diligence to reduce the invention to practice from before the other party's date of conception until its reduction to practice is achieved. *Mahurkar v. C. R. Bard, Inc*., 79 F.3d 1572, 1577, 38 USPQ2d 1288, 1290 (Fed. Cir. 1996).

A party that is both first to conceive of the subject matter of the count and first to reduce it to practice is deemed the "first to invent." *Eaton v. Evans*, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000); *Hyatt v. Boone*, 146 F.3d 1348, 1351, 47 USPQ2d 1128, 1129 (Fed. Cir. 1998). Reduction to practice may be "constructive reduction to practice" or an actual reduction to practice. A constructive reduction to practice occurs when the inventor files a patent application describing the invention, teaching how to make and use the invention, and explaining the best mode of practicing the invention, i.e., meets the requirements of §112, first paragraph. *Feldman v. Aunstrup*, 517 F.2d 1351, 186 USPQ 108 (CCPA 1975). An actual reduction to practice is a question of law which is resolved on the basis of underlying facts. *Estee Lauder, Inc. v. L'Oreal, S.A.*, 129 F.3d 588, 592, 44 USPQ2d 1610, 1613 (Fed. Cir. 1997). Specifically, in an interference proceeding, a party seeking to establish an actual reduction to practice must satisfy a two-prong test: (1) the party constructed an embodiment that met every requirement of the interference count, and (2) the embodiment operated for its intended purpose. With regard to the first prong, precedent requires that the constructed embodiment include the precise requirements

recited in the count. Thus, for purposes of an interference, there can be no actual reduction to practice if the constructed embodiment lacks an element recited in the count or uses an equivalent of that element. *Eaton*, 204 F.3d at 1097, 53 USPQ2d at 1698.

In an interference between a patent and an application having a filing date on or before the issue date of the patent, the burden of proof to establish priority is by a preponderance of the evidence. 37 CFR § 1.657(b). The burden of showing something by a preponderance of the evidence simply requires the trier of fact to believe that the existence of a fact is more probable than its nonexistence before the trier of fact may find in favor of the party who carries the burden. *Concrete Pipe & Products of California, Inc. v. Construction Laborers Pension Trust for Southern California*, 508 U.S. 602, 622, 113 S. Ct. 2264, 2279 (1993).

Both Gambaro and Goddard allege an actual reduction to practice prior to their effective filing dates for the subject matter of Count 1. Gambaro '322 has an effective filing date of January 11, 1993 and Goddard '949 has an effective filing date of February 22, 1993. (Paper No. 1 and 2, Notice Declaring Interference). Accordingly, for purposes of priority, Goddard has the initial burden of establishing an actual reduction to practice date prior to the Gambaro '322 filing date of January 11, 1993.

A. Goddard's Alleged Reductions to Practice

As set forth in Goddard's Brief (Paper No. 226), Goddard's invention relates to "hand-held devices ***designed for the efficient entry of information into electronic systems*** using a keyboard having a housing with a grippable portion to allow the device to be held in one hand with the thumb free to move to various predetermined key-actuation positions while the device is held." (Goddard's Brief, p. 1, emphasis added). The brief alleges that Goddard reduced the invention of Count 1 to practice by "actually making structure which embodied each and every structural limitation of the count by at least as early as March 10, 1989." (Goddard's Brief, p. 13). More specifically, Goddard allegedly constructed eight prototype controllers, which are referred to as Models A1, 1, 2, 3, 4, 5, 6 & 7. The controller models and their dates of construction are described below.

1. Goddard Controller Model A1

According to Goddard's Brief, on December 17, 1988, Goddard conceived and began work on a pistol-like controller that would be easy to point and use, with controls operated by thumb and fingers. (Goddard's Brief, pages 4-5; Goddard Declaration, ¶ 4; Champion Declaration, ¶ 5). This work continued into January 1989, when on January 11, 1989, Goddard is said to have constructed pistol-like television controller device "Model A1." (Goddard's Brief, page 5; Goddard Declaration, ¶ 8; Champion Declaration, ¶ 4). Photographs of Model A1, taken on January 11, 1989, were provided as Goddard Exhibits J1[2] and J2. Exhibit J1, according to the brief, is a photograph of a Mr. William M. Champion, Jr., "holding the controller device in his right hand with his fingers gripping it and his right thumb hidden by the device, positioned

[2]Junior party Goddard's exhibits begin with the letter "J." Senior party Gambaro's exhibits begin with the letter "S."

to push keys ***which were to be located in the concavity***." (Goddard's Brief, p. 5, Exhibit J1, Goddard Declaration, ¶ 8; Champion Declaration, ¶ 4, emphasis added). Exhibit J2 is described as a photograph, which shows the presence of a concavity and grip on the left-hand side of controller Model A1. (Goddard's Brief, p. 5, Exhibit J1, Goddard Declaration, ¶ 8; Champion Declaration, ¶ 4). The brief, however, alleges that "Model A1 had all the elements of the invention." (Goddard's Brief, p. 6).

2. Goddard Controller Model 1

Goddard is said to have constructed seven additional prototypes of the controller. In particular, controller Model 1 is said to have been constructed on January 13, 1989 and is depicted in a photograph marked as Goddard Exhibit J3. (Goddard's Brief, p. 6, Goddard Declaration, ¶ 11; Champion Declaration, ¶ 7). A notebook page marked as Goddard Exhibit J13 shows a rough drawing and description of the Model 1 controller. (Goddard's Brief, p. 6). Exhibit J13, has the date January 13, 1989 written at the top of the page and was witnessed by Mr. Champion on January 24, 1989. (Champion Declaration, ¶ 7). Exhibit J13 depicts controller Model 1 as having a thumb pad with a 15-button keypad placed thereon. Moreover, while not depicted in exhibit J3, controller Model A1 is said to have possessed a "thumb pad having a 15-button keypad in a concavity." (Goddard's Brief, p. 6, Goddard Declaration, ¶ 11; Champion Declaration, ¶ 7).

3. Goddard Controller Model 2

Mr. Goddard is said to have ***begun*** construction of controller model, Model 2, on about January 24, 1989.[3] (Goddard's Brief, p. 6, Goddard Declaration, ¶ 12; Champion Declaration, ¶ 9, emphasis added). The overall design for controller Model 2 is presented in Goddard notebook pages 30 and 31 which are marked as Goddard Exhibits J14 and J15. Exhibit J15 depicts controller Model 2 as possessing a thumb-pad having a keypad.

4. Goddard Controller Model 3

On about February 13, 1989, Mr. Goddard is said to have ***begun*** making controller Model 3, which possessed a thumb pad concavity just to the left of the grip portion. (Goddard's Brief, p. 6, Goddard Declaration, ¶ 14; Champion Declaration, ¶ 10, emphasis added). A photograph of controller Model 3 is provided as Goddard Exhibit J4.[4] According to the brief, "one can clearly see the metallic key positions located in the concavity where they are thumb actuated." (Goddard's Brief, p. 7, Goddard Declaration, ¶ 14; Champion Declaration, ¶ 10). As depicted in Exhibit J4, there does appear to be a metallic device, i.e., thumb tacks, in a thumb pad. Interestingly, in response to an interrogatory regarding fabrication of a device with actual switches, Goddard stated that:

> The metallic devices inserted in Model 3 were capable of carrying current, and thus functioning as a device for making, breaking, or changing the connections in an electrical circuit. The date of Model 3 was on or about February 13, 1989.

(Goddard Record, p. 21, Goddard Answers to Written Interrogatories, Interrogatory No. 8).

5. Goddard Controller Model 4

Continuing to work on the controller device design, Goddard is said to have ***begun*** making controller Model 4 on about February 23, 1989.[5] (Goddard's Brief, p. 7, Goddard

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[3] Goddard does not appear to have mentioned an exact date of completion for the construction of the Model 2 controller.

[4] Goddard's brief does not appear to have provided a exact date of completion for the construction of his Model 3 controller. In the photograph of Model 3, Exhibit J4, there is a piece of paper with a date of February 13, 1989. Furthermore, the declaration of Mr. Jeffrey S. Caldwell verifies that the photograph depicted in Goddard Exhibit J4 was taken in early 1989. (Caldwell Declaration, ¶4).

[5] Goddard's brief does not appear to have provided a exact date of completion for the construction of his Model 4 controller. In the photograph of Model 4, Exhibit J5, there is a piece

Declaration, ¶ 15; Champion Declaration, ¶ 11, emphasis added). This model is said to have provided a larger thumb pad concavity centered above the grip. (Goddard's Brief, p. 7, Goddard Declaration, ¶ 15; Champion Declaration, ¶ 11). A photograph of controller Model 4 is provided as Goddard Exhibit J5.

6. Goddard Controller Model 5

Design and construction of controller Model 5 is said to have ***begun*** on March 2, 1989.[6] (Goddard's Brief, p. 7, Goddard Declaration, ¶ 16; Champion Declaration, ¶ 12, emphasis added). Model 5 is described as having a deeply dished thumb pad to minimize thumb flexion when touching buttons near the center. (Exhibit J18).

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of paper with a date of February 23, 1989. Furthermore, the declaration of Mr. Jeffrey S. Caldwell verifies that the photograph depicted in Goddard Exhibit J5 was taken in early 1989. (Caldwell Declaration, ¶4).

[6] Goddard's brief does not appear to have provided a exact date of completion for the construction of his Model 5 controller. Goddard's notebook page 31, dated March 2, 1989 does state "Model #5, the first 2-finger trigger model, is now about finished and has been quite illuminating." (Exhibit J18).

7. Goddard Controller Model 6

Goddard ***began*** design and construction of yet another model, controller Model 6, on about March 5, 1989.[7] (Goddard's Brief, p. 7, Goddard Declaration, ¶ 17; Champion Declaration, ¶ 13, emphasis added). This Model 6 is said to have "had a grippable portion to permit the controller device to be held in one hand with the thumb free to move among keys clustered in a concavity to enter information into the controller to control and use the television or other electronic device." (Goddard's Brief, p. 7). A picture of Model 6 is provided as Exhibit J6.

8. Goddard Controller Model 7

Goddard designed and ***began*** to make controller Model 7 on about March 10, 1989.[8] (Goddard's Brief, p. 8, Goddard Declaration, ¶ 18; Champion Declaration, ¶ 14, emphasis

[7] Goddard's brief does not appear to have provided a exact date of completion for the construction of his Model 6 controller. Goddard's notebook page 37 having a heading date of March 5, 1989, however, does state "Yes, Model #6 finally demonstrates the power of the original concept. It will give a vivid demonstration of the 'World at your Fingertips.'" (Exhibit J19). Furthermore, the declaration of Mr. Jeffrey S. Caldwell verifies that the photograph depicted in Goddard Exhibit J6 was taken in early 1989. (Caldwell Declaration, ¶4).

[8] Goddard's brief does not appear to have provided a exact date of completion for the construction of his Model 7 controller. Goddard's notebook page 50 having a heading date of March 10, 1989, does state "block is too moist; so the crude form of Model #7 must dry till tomorrow." (Exhibit J20). Furthermore, the declaration of Mr. Jeffrey S. Caldwell verifies that the photographs depicted in Goddard Exhibits J7 and J8 were taken in early 1989. (Caldwell Declaration, ¶4).

added). Pictures of controller Model 7 are provided as Exhibits J7 and J8. According to the brief, Model 7 possessed a large pistol grip with eleven keys in addition to the thumb pad concavity. (Goddard's Brief, p. 8).

According to Goddard's Brief, each of the Models had a housing with a grippable portion to allow the device to be held in one hand. Further, when held, the thumb was free to move to various predetermined key-actuation positions. It is also alleged that there was a concavity in the housing of each model holding key positions or keys where horizontal and vertical movement and thumb pressure could select the keys. From this, Goddard concludes that by at least March 10, 1989 he had built and demonstrated hand-held devices for entering information into an electronic system via a keyboard. (Goddard's Brief, p. 8). The brief does state, however, that "the ultimate commercialization of the invention will use conventional chips on circuit boards that are commercially available and will use conventional key structures." (Goddard's Brief, p. 9).

The testimony and photographs submitted in Goddard's Record are inconsistent. For instance, the declarations of Goddard and Champion state:

> Within the concavity there was a thumb-associable cluster of keys forming a keyboard, and each of the keys was selectively actuated using lateral and slight endo translations of the thumb within the concavity. Each of Models A1, 1, 2, 3, 4, 5, 6 and 7 demonstrated these features.

(Goddard Declaration, ¶ 20; Champion Declaration, ¶ 17). Yet the declarations also state: "There was a concavity in the housing of each model ***holding key positions*** or keys where the keys could be selected by horizontal or vertical movement and thumb pressure." (Goddard Declaration, ¶ 19; Champion Declaration, ¶ 15, emphasis added).

According to the declarations and representations of Goddard's counsel at oral hearing, Models A1, 1, 3, 4, 6 and 7 are shown in photograph exhibits J1-J6. The photographs, with the

exception of Model 3, do not show any keys forming a keyboard, i.e., requirement **[5]**. Goddard's counsel confirmed during oral hearing that, with the exception of Model 3, the photographs did not show the presence of keys on the models. As to Model 3, Goddard's counsel represented that the "thumbtacks" of Model 3 that are visible in photographic exhibit J4 were keys that were capable of making, breaking or changing current in an electrical circuit.

In light of the photographs and oral representation by Goddard's counsel, Goddard has failed to establish that keys were present in Models A1, 1, 4, 6 and 7 as constructed and photographed. We further conclude that the declarations of Goddard and Champion fail to establish, by a preponderance of the evidence, the presence of keys in Models 2 and 5 as constructed. Furthermore, with respect to Model 3, Goddard has not pointed to any evidence that the thumb-tack like metallic objects on the surface of the concavity of Model 3 had selectable "on" and "off," or "open" and "closed" positions. Because the count requires selectively actuable keys it is implicit that the keys must have alternating "on" and "off," or "open" and "closed" positions or their electronic equivalent. The evidence on this record is insufficient to establish that these thumb-tack like metallic devices were operative keys for entering information into an electronic system.

B. Gambaro's Opposition to Goddard's Brief on Alleged Reduction to Practice

Gambaro opposes Goddard's alleged reduction to practice. According to Gambaro, a key feature of the invention of Count 1, is the coupling of the hand-held device to an electronic system. (Gambaro's Opposition, pages 4 and 13). Gambaro argues that there is no evidence that any of the models shown in Exhibits J1 through J8 were ever connected to an electronic system. As such, it is Gambaro's position that Goddard failed to actually reduce to practice a device falling within the scope of Count 1. (Gambaro's Opposition, pages 4 and 13). Moreover, Gambaro contends that the fact that the metallic devices inserted in Model 3 were capable of carrying current does not necessarily demonstrate that current ever flowed between any of the metallic devices. (Gambaro's Opposition, p. 15).

C. Goddard's Reply to Gambaro's Opposition

Of note, Goddard argues that the invention of Count 1 is an ergonomic keyboard design. (Goddard's Reply, p. 1). According to Goddard, Gambaro has ignored Goddard's evidence that the design of the Goddard models meets the terms of the count and that the models were for the purpose of entering information into an electronic system. Goddard further argues that the design of Model 3 possessed metallic key positions located in a concavity, which was for the purpose of entering information into an electronic system. (Goddard's Reply, p. 2).

D. Goddard Lacks Sufficient Proof of a Reduction to Practice Prior to Gambaro's Filing Date

As mentioned above, Goddard has the burden, by a preponderance of the evidence, of

establishing a reduction to practice prior to Gambaro's filing date. Goddard has failed to meet his burden.

In establishing an actual reduction to practice, Goddard must demonstrate that he constructed a hand-held device that met every requirement of interference Count 1. *Eaton v. Evans*, 204 F.3d at 1097, 53 USPQ2d at 1698. As set forth in requirements **[2]** and **[6]**, Count 1 requires a hand-held device which has the ability to enter information into an electronic device. Yet, none of Goddard's models were proven to have been capable of delivering information in any form, let alone entering information into an electronic system. Moreover, Goddard has failed to establish that the models possessed selectively actuable keys. All of Goddard's Models A1 and 1 through 7 are merely demonstrative models or mock-ups of the outer appearance of a hand-held device. In their form as constructed, they could not be expected to perform the claimed function of entering information into an electronic system. Accordingly, Goddard's models were not devices which met every requirement of the count.

Even accepting Goddard's argument that Model 3 possessed metallic keys for the purpose of entering information into an electronic system, Goddard has failed to demonstrate that the Model 3 controller was actually capable of entering such information. The "thumb tacks" of Model 3 have not been shown to have been electronically connectable to any other component in the mock-up. Thus, none of the models have been shown to have been an actual working device. At most, they represented only a unit in the midst of construction, i.e., a work-in-progress. As such, these models were not complete devices and do not establish an actual reduction to practice. *Newkirk v. Lulejian*, 825 F.2d 1581, 1583, 3 USPQ2d 1793 (Fed. Cir. 1987) (Proof of actual reduction to practice requires more than theoretical capability).

Moreover, proof of actual reduction to practice requires a showing that the embodiment relied upon as evidence of priority actually worked for its intended purpose. *Eaton v. Evans*, 204 F.3d at 1097, 53 USPQ2d at 1698; *DSL Dynamic Sciences Ltd. v. Union Switch & Signal, Inc.*, 928 F.2d 1122, 1125, 18 USPQ2d 1152, 1154 (Fed. Cir. 1991). As recognized in Goddard's Reply Brief: "The purpose of the ergonomic keyboard design if [sic] for a hand-held device for use with an electronic system." (Goddard Reply Brief, Paper No. 223, p. 2). Thus, Goddard must show that the device worked for this purpose in order to demonstrate an actual reduction to practice of the invention embodied in Count 1. Yet, even if we were to assume that requirements **[2]** and **[6]** were not part of the count, Goddard has failed to establish that the devices actually worked for their intended purpose of transferring information to an electronic device. As stated in Goddard Interrogatory Answer No. 4, Goddard has admitted that: "No fabricated hand-held device designed by party Goddard is known to have entered information into an electronic system prior to the filing of the application of party Goddard." (Goddard Record, p. 20, Goddard Answers to Written Interrogatories, Interrogatory No. 4). Accordingly, even were we to accept Goddard's models as finished products, Goddard has failed to establish an earlier reduction to practice of a device according to Count 1 by a preponderance of the evidence.

V. Junior Party's Renewed Motion for Benefit

During the time period for filing preliminary motions, Goddard filed a preliminary motion under 37 CFR § 1.633(f) to be accorded the benefit of an earlier filing date. That motion was denied on January 12, 1999. (Paper No. 44). In its brief for final hearing, Goddard included

a section renewing that preliminary motion for benefit. The renewed motion is an attempt to seek review at final hearing of the decision of January 12, 1999, denying Goddard's motion for

benefit. Under 37 CFR § 1.640(b), however, a party must have timely given advance notice of all the issues it desires to have reviewed at final hearing. By stipulated schedule filed on January 5, 2000 (Paper No. 68), the due date for filing the Rule 640(b) notice was set for July 1, 2000. On June 30, 2000, party Gambaro filed its Rule 640(b) notice of issues to be reviewed at final hearing. Goddard never filed such a Rule 640(b) notice. Consequently, party Goddard has waived review of the administrative patent judge's denial of its preliminary motion for benefit. Failure to comply with the notice requirement is not a mere "technicality," since the requirement is intended to permit the opposing party an opportunity to include applicable evidence in the record on which it would rely with respect to the issue to be raised. Accordingly, the renewed motion for benefit is dismissed.

VI. Issues of the Senior Party which are Moot

Because Goddard has failed to demonstrate an actual reduction to practice prior to Gambaro's filing date there is no occasion to reach Gambaro's priority case. Likewise, as Goddard's claims corresponding to Count 1 are unpatentable under 35 U.S.C. § 102(g), we do not reach that portion of Gambaro's preliminary motion 2, which was deferred to final hearing, concerning the alleged unpatentability of the Goddard's claims under 35 U.S.C. § 102(e)/103.

Consequently, Goddard's motion to exclude Gambaro's evidence (Paper No. 225) is dismissed as moot and that portion of Goddard's Preliminary Motion 2 which has been deferred to final hearing is dismissed as moot. Also moot is Gambaro's Miscellaneous Motion 7 which renews its Miscellaneous Motion 5, previously denied, for leave to correct Gambaro's preliminary statement. That motion is herein dismissed as moot.

Additionally, as Goddard loses even with all of his evidence not suppressed, the Gambaro's Motion 14 to exclude Goddard's evidence is moot. Specifically, even considering the entirety of Goddard's evidence, Goddard has not established an actual reduction to practice. Accordingly, Gambaro's motion to exclude evidence is dismissed.

Along with its principal brief, Gambaro filed a Miscellaneous Motion 18 requesting the imposition of sanctions against Goddard under 37 CFR § 1.616 for taking frivolous positions in this interference. Gambaro requests an award of one hundred and sixty thousand dollars, $160,000, or greater.

Rule 1.616(a) permits an award of compensatory expenses and/or compensatory attorney fees for the failure of a party to comply with a regulation or with any order entered by an administrative patent judge or the Board. Rule 1.616(b) states:

> An administrative patent judge or the Board may impose a sanction, including a sanction in the form of compensatory expenses and/or compensatory attorney fees, against a party for taking and maintaining a frivolous position in papers filed in the interference.

Initially, Gambaro points to a plethora of mis-citations in Goddard's papers filed in this interference. The misstatements include a date as November 20, 1992, when the actual date is November 30, 1992; a date as January 6, 1991, when the actual date is June 6, 1991; and the citation of 37 CFR § 1.663(f) when the actual rule is 37 CFR § 1.633(f). These mistakes are self-apparent. Even Gambaro has referred to them as "obviously incorrect." These mis-citations reflect general sloppiness of counsel, short of something so reprehensible and innumerable that an award of any compensatory expenses and/or attorney fees could be justified.

Gambaro also asserts that because Goddard failed to file an appropriate notice under 37 CFR § 1.640(b), Goddard was precluded from re-arguing the denial of Goddard's motion for benefit under 37 CFR § 1.633(f). That is correct. Yet, we do not see any justification for awarding expenses and attorney fees for party Goddard's inclusion of a section in its brief regarding its denied motion for benefit. The only consequence that should ensue is that the section in the brief shall not be considered, as is already our decision here.

Finally, Gambaro asserts that Goddard's entire case on priority, relying on an alleged prior actual reduction to practice, is frivolous, because the devices actually constructed were

never shown to have entered information into an electronic system. Goddard, however, is entitled to its "day in court" on that issue. The fact that Goddard lost on the merits does not mean its position before this board was frivolous. *Sparks v. Eastman Kodak Co*., 230 F.3d 1344, 1345, 57 USPQ2d 1158, 1159 (Fed. Cir. 2000) (A frivolous appeal must be more than one that has little merit. The doors of the courthouse must remain open for losing appeals as well as winning appeals.)

For the foregoing reasons, Gambaro's motion for sanctions in terms of an award of compensatory expenses and attorney fees is denied.

V. Judgement

Upon consideration of the record, and for the reasons given herein, it is:

ORDERED that judgment on priority as to Count 1 (Paper No. 1 and Paper No. 2, Notice Declaring Interference), the sole count in the interference, is awarded against Junior Party Goddard.

FURTHER ORDERED that junior party Goddard is not entitled to a patent containing claims 26-28, 30 and 31 (corresponding to Count 1) of Goddard U.S. Application No. 07/982,949, filed February 22, 1993.

FURTHER ORDERED that a copy of this final decision shall be placed and given a paper number in the file of Goddard U.S. Application No. 07/982,949 and in Gambaro U.S. Patent No. 5,322,322

FURTHER ORDERED that if there is any settlement agreement which has not been filed, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.

FRED E. McKELVEY Senior Administrative Patent Judge	)
JAMESON LEE Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
MICHAEL P. TIERNEY Administrative Patent Judge	)

cc: (via Express Mail)

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